

## REMARKS

A Request for Continuing Examination (with one month extension of time request) is filed herewith.

The final rejection action of 8 October 2008 does show a continuing misunderstanding of the invention particularly re nexus of objective factors to claimed subject matter. This amendment is submitted to overcome such misunderstandings and further clarify distinction of the invention over prior art. Claims 1, 2, 4, 6, 8, 11, 12, 14, 15, 25-28 are cancelled previously or via this amendment made in this Response, and claims 3, 5, 9 and 16-20 are withdrawn, leaving claims 4, 10, 13 and 21-24 pending.

Claim revision is shown above in the mark to show presentation of claims. Below, Applicant resubmits a summary of Remarks of his 27 June 2008 response with added annotation of (a) related Examiner comments of the 8 October 2008 action and (b) response now made to such comments.

A phone interview is requested with Examiner Katcheves and with Supervising Examiner Glessner participating. Please call Applicant's attorney, Jerry Cohen, at (617) 345-3000 after reviewing this response to arrange such an interview. Thank you.

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### **Background:**

In the 4 April 2008 action [then pending] claims 4, 8, 10, 11, 13, 21 and 25 were rejected as anticipated by Anderson '887 issued Nov. 14, 1922 (USP 1,436,887, issued November 14, 1922), claims 12 and 24 were rejected as obvious in relation to to Anderson; claims 22, 23 and 26-28 were rejected as obvious in relation to a combination of Anderson '887 and Gunvalson '875 (USP 3,703,875, issued Nov. 28, 1972); claims 3, 5, 9, 16-20 remained withdrawn from consideration. The previous prior art rejection based on Place and Hight et al. was withdrawn and 53 patents were cited of interest. The rejections were respectfully traversed in the June 27, 2008 Response. It was noted that the 53 references cited of interest had been studied carefully and responsive comments were made. The Examiner was asked to review the

comments and see if there is a pertinence to any one or more of them intended by the Examiner's selection.

1. The June 27, 2008 Response pointed out that Anderson '887 Does Not Anticipate Claims 4, 10, 13 and 21 (nor render any of them unpatentable under sec. 103).

The June 27, 2008 Response showed that Anderson '887 describes an aligning clip for installing and aligning gaskets with flanges of pipe sections. The clips are not constructed for and are not taught as attachment points for deck mounted objects as described and claimed in the present application and not realistically capable of such function. It was pointed out that the Anderson clip needs to be a high deflection/compression spring operable with finger pressure to fulfill the function taught in the '877 patent. It compresses to fill a hole then expands to hold aligned parts in place. It is not configured to pass through a narrow gap between parallel boards and rotate for holding as described and claimed herein.

The reference shows a product designed, configured and actually for aligning two end-to-end adjacent pipes with an intermediate gasket or other assembled product. See col. 1, ll. 9-23. It was also noted in the June 27, 2008 Response that the clips can't pass through the holes of the pipe flanges or gasket unless compressed while in the present invention compression is unnecessary to passage in gaps of deck boards and the holding strength of the clips of the present invention would be vitiated by using the high degree of compression/release shown in Anderson '887.

(1a) Examiner Comments in the 8 October 2008 action: The Examiner stated in the 8 October 2008 action that Anderson's ('887) clip of his FIG. 3 is capable of securing objects to a top surface of a deck because it discloses a wire with an aperture forming closed head, closely spaced parallel legs and orthogonal feet and the head and feet larger than a deck gap [if] the clip is inserted and rotated as Applicant teaches in its specification. This was coupled with an objection to claims 21, 25 as not positively claiming a deck or dock structure.

(1b) Applicant's Response: First, the legs are not parallel nor adjacent. Further, they are not straight. They necessarily have a form in relaxed state to allow a large range of compression-transition to pass through a hole by fingertip compression of the legs. The "legs"

are not long enough to fit a deck. The construction is entirely for compressing to fit through a hole (rotation would not matter), the Anderson clip is not at least about 1/8 in. diameter. Light fixtures and clips as seen in Anderson are ubiquitous (and have been so since the 1922 period of Anderson's patent and likely are found in furnishings at the U.S. Patent & Trademark Office). Inspecting any of them shows clips of about 10 mils (i.e. .01 inch) vs. about .125 inches (125 mils) in the present invention - a 10 X difference).

The objections of not claiming a deck combination is traversed. A structure of a clip can be claimed with reference to an exterior target structure of its usage. This is similar to identifying a workpiece or environment in a product claim to show how the product is made with reference to function it is intended to fulfill. See Landis, MECHANICS OF CLAIM DRAFTING (4th Edition) § 16A ("Workpiece or Environmental Element"). A copy of that section is provided at Appendix C hereto. As Landis points out this type of claiming makes a copier of the claimed product a direct infringer rather than a contributory infringer. Landis gives guidelines for such a claim (consistent with PTO Guidelines and practices) that are followed herein.

However, claims 22-24 do recite the combination.

Remaining claims of the above group (4, 10, 13 and 22-24) depend on claim 21 and, *a fortiori*, are not anticipated. None of claims 10, 13 or 21 are anticipated or suggested obvious in view of Anderson.

2. The June 27, 2008 Response asserted that Claim 24 Reciting A One Inch Length Is Not Unpatentable as Obvious in Relation to Anderson '887.

The earlier argument now applies as well. It was not a matter of obvious design choice to select materials for the products of the present invention and in fact considerable study and experimentation was done.

(2a) Examiner Comments: The Examiner stated in the 8 October 2008 action that changes of size are matters of design for one skilled in the art.

(2b) Applicant's Response: Which art is one talking about? The art of aligning gaskets is far from the art of securing tarpaulins or heavy articles such as grilles to decks. For some 96 years since Anderson no one has realized Applicant's present invention. Applicant and his licensee had technical and commercial success directly related to the herein described and claimed structure as shown in the enclosed Declaration.

3. The June 27, 2008 Response Argued Claims 22, 23 Are Not Unpatentable Over Any Valid Combination of Anderson '887 and Gunvalson '875.

The above remarks as to Anderson '887 were incorporated by reference. It was asserted (and now maintained) that as to Gunvalson '875. the vessel mooring or anchoring device described therein is a rigid bracket that passes between dock boards and is rotated but, contrary to the present invention (a) is not a wire and (b) has a small, circular head for attachment smaller than the gap between dock boards, not one which is greater than such gap as described and claimed herein. The circa 1972 device of Gunvalson is wholly different from the spring clip in Anderson's 1922 clip in design, configuration, purpose and function. The small head of Gunvalson is supplemented by extra arms 14, 15 not needed in the present invention and indeed the extra arms, aside from adding costs, limit the ability to accommodate variation of thickness of deck or dock boards. It was asserted (and now maintained) that there is no reason to combine the references and in the nearly four decades since the later Gunvalson reference or the nine decades since Anderson no one has done so. It was asserted (and now maintained) that the present invention created a new product category and enjoyed technical and commercial success based on merit of the inventive product, all as shown in the Rule 132 Declaration.

(3a) Examiner Comments: The Examiner stated in the 8 October 2008 action, in view of Anderson it would have been obvious at the time the present invention was made to use the clip of Anderson in the "combination" taught by Gunvalson.

(3b) Applicant's Response: Again, which art? What "combination"? Gunvalson has two upper arms, as an element of combination and a separate head. Anderson has no relation to Gunvalson's purpose or Applicant's purposes. The original Remarks at 3 above are reiterated. In particular, in making the postulated substitution of Anderson into such a combination, one would

have to discard Anderson's main teaching of expansion-compression. The presently described and claimed structure with its functionality of construction and use is taught by Applicant alone.

4. It Was Asserted (And Now Maintained) That The Rule 132 Declaration of 30 September 2007, Supplemented 6 March 2008, was Misunderstood in the 4 April Action.

The prior declaration referred to the present invention as a new product category displacing prior make-shift artifacts which were unsatisfactory. The declaration also showed that the inventor/applicant has no significant capital or marketing resources. The inventive product succeeded on its own merit.

(4a) The Examiner stated in the 8 October 2008 action: 'The declaration has been considered. Ordinary skill of the art may be invoked in support of a combination.' Reference was made to prior discussion in earlier actions [but those only show a question of nexus of benefits to claimed subject matter, a question well resolved in the claims and declaration now presented.]

(4b) Applicant's Response: The action did not state any lack of correspondence between the claimed structure and the secondary factors of the declaration. Again, what art? With due respect, statutes, rules and PTO practice requires a reasoned, fact based statement of basis of an obviousness rejection.

5. It Was Asserted (And Now Maintained) That The References Cited in the June 27, 2008 Action as Being of Interest taken alone or with each other or Anderson or Gunvalson in any valid combination do not anticipate, suggest or render obvious any claims. It was noted by Applicant that the plethora of prior art available to those skilled in the art for most of the last 100 years without yielding the present invention is further evidence of non-obviousness. Applicant submitted the following brief summary of the 53 references and invited the Examiner to add to the comments if the Examiner had anything else in mind as in producing such an extraordinary burden on an independent inventor.

- 26,975 – A lever for turning faucets in a pipe. An internal T-shaped part. It is not applicable.
- 29,041 – A harmonium (musical instrument). Internal I-shaped parts. It is not applicable.
- 1,435,887 – The ANDERSON patent upon which claims were rejected. Discussed above.

- 1,441,737 – A wire sling hook for wrapping ropes around and lifting sacks. It is not applicable.
- 1,510,737 – Various forms of a wire hook for the top of a wooden clothes hanger. It is not applicable.
- 2,020,206 – PLACE – This was previously cited and withdrawn as a basis of rejecting claims.'
- 2,024,805 – PLACE – More variations of his clips, already addressed. It is not applicable.
- 2,043,007 – PLACE – Even more variations of his clips, already addressed. It is not applicable.
- 2,096,648 – PLACE – This was previously cited and withdrawn as a bar of rejecting claims.
- 2,215,428 – PLACE – Yet more variations of his clips, already addressed. It is not applicable.
- 2,221,009 – Spring clip for securing hollow moldings to apertured support. A variation of Place's clips by another inventor. It is not applicable.
- 2,260,690 – PLACE – Still even more variations of his clips. It is not applicable.
- 2,275,553 – PLACE – Still more variations. . It is not applicable.
- 2,392,648 – A package tie clip for tying string around a box (like ribbon on a gift box). It is not applicable.
- 2,406,665 – A clip similar to Place's clip, used for securing a covering to a surface. It is not applicable.
- 2,563,240 – Spring loaded sheet metal clip similar to Place's for attaching items to an apertured support. It is not applicable.
- 2,567,508 – Spring loaded fastener similar to Place with cam mechanism attached to lock into place. It is not applicable.
- 2,659,950 – Another variation of Place's clips by another inventor for securing moldings such as automobile trim. It is not applicable.
- 2,666,240 – The springs in spring clips that are on the bottom of clothes hangers (e.g. as for hanging pants or skirts). It is not applicable.
- 2,740,179 – Another variation of Place's clips by another inventor. Tyned feet to bite into one material. Such as securing rubber weather seals to an automobile body. It is not applicable.
- 2,754,561 – Further sheet metal variations of Place's clip for attaching moldings. It is not applicable.
- 2,830,345 – Even more variations of Place's clip for attaching rubber moldings. It is not applicable.
- 2,935,770 – Variations of clips similar to Place for attaching weather strips. It is not applicable.
- 3,703,875 – GUNVALSON –discussed above.
- 3,864,789 – Variations of clips similar to Place for attaching weather strips. It is not applicable.
- 4,078,512 – Spring clips attached to a boat anchor. It is not applicable..
- 4,221,039 – Almost exactly identical to Place, but used for temporarily aligning gaskets. This is essentially the same as the ANDERSON reference which was used to reject claims. The above arguments apply to overcome this reference.
- D258,138 – Design patent showing wire clips, but none that are the same as mine.

- 4,297,963 – Boat mooring clip consisting of shaft, coil spring, and washers. It is not applicable.
- 4,899,680 – Boat mooring clip very similar to GUNVALSON. Slight variations and showing extra applications. Extra set of arms as in GUNVALSON. The above arguments apply to overcome this reference.
- D321,470 – Design patent showing wire clips, none are the same as present claims.
- 5,210,912 – Coupling member and cleat, attaching ropes to other ropes. This was addressed in previous responses. It is not applicable.
- 5,412,848 – Hinged spring clip for wall fasteners. Multiple components. It is not applicable.
- 5,806,149 – A spring clip for attaching gaskets, similar to Place. It is not applicable.
- 5,879,101 – Another spring clip similar to Place, but legs extend back as a shield. It is not applicable.
- 5,897,278 – A turn fastener used for assembling two panels together. It is not applicable.
- D411,099 – A formed tie-down hook. Shape not similar to mine. It is not applicable.
- 5,967,075 – A spring loaded mooring device. Multiple components and coil spring. It is not applicable.
- 6,244,541 – A spring loaded retaining clip is used for wiring harnesses. Spring action is the key requirement, and the description includes all of the spring calculations required to make it work. It is not applicable.
- 6,295,942 – A docking clip having threaded nuts above and below a surface to clamp it. It is not applicable.
- 2002/0048495 – A “T” shaped cargo tie down fastener, probably similar to the one described in the next reference, 2003/0053879. It is not applicable.
- 2003/0053879 – “U” shaped sheet metal tie hooks that latch into holes in a channel as part of a truck bed cargo fastening system. It is not applicable.
- D477,255 – Design patent for a bolt-down bicycle parking rack. It is not applicable.
- 6,647,911 – Multiple component docking clip, friction loaded slide down clip. It is not applicable.
- 6,793,189 – A plastic clip of similar function to mine, but completely different in design and construction.
- 6,799,927 – A pickup truck bed rail system. No clips. It is not applicable.
- 6,805,247 – The bicycle locking stand from Design Patent D477,255 above. It is not applicable.
- 7,120,971 – A spring loaded fastening clip, variation of Place’s clips. It is not applicable.
- 2007/0025822 – A multi-component hinged fastener for trucks and trailers. It is not applicable.
- 2007/0292229 – A published application filed later than the present one.
- 2008/0014041 – A published application filed later than the present one.
- 7,334,764 – Multiple plates with sockets and fibers to attach to a surface. It is not applicable.

(5a) Examiner Response in the October 8, 2008 Action: The Examiner stated that arguments against references not applied are gratuitous.

(5b) Applicant's Response: But the Examiner has still not answered the question of why so many references were cited, placing a great burden on an independent inventor and imposing an obligation on the inventor to study them and compare them to the presently claimed invention. As it turns out these abundant references, declared important enough to cite but not apply, are themselves corroborative of unobviousness of the presently claimed invention.

In view of all the foregoing allowance of the now presented amended claims 4, 10, 13 and 21-24 is requested.

Please note again the request for telephone interview stated above, call Applicant's attorney, Jerry Cohen, at 617-345-3000 in advance to arrange the interview at a time when the Applicant/Inventor can participate. Thank you.

If any sums are owed due to claims adjustments, please debit or credit Deposit Account 03-2410. A duplicate copy of this page is enclosed for accounting purposes.

Respectfully submitted,

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Dated: February 6, 2009

By: 

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Enclosures: Appencix A (clean set of claims), Appendix B (Rule 132 Declaration with Exhibits 1-6), Appendix C (Extract from Landis - Claim Drafting Treatise)